

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 15651-002001
	Application Number 10/697,767	Filed October 30, 2003
	First Named Inventor Andrew Schydrowsky	
	Art Unit 3693	Examiner Richard C. Weisberger

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 42,782
 (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
 Registration number if acting under 37 CFR 1.34 _____



 Signature

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 Typed or printed name

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 Telephone number

 1/17/2008
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andrew Schydlowsky
Serial No. : 10/697,767
Filed : October 30, 2003
Title : CUSTOM FOOD

Art Unit : 3693
Examiner : Richard C. Weisberger
Conf. No. : 8887

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant submits this request pursuant to the Pre-Appeal Conference Pilot Program described in the United States Patent and Trademark Office OG Notice "New Pre-Appeal Brief Conference Pilot Program," dated 12 July 2005. This request is filed together with a Notice of Appeal. Review of the matters identified below by a panel of examiners is requested because the rejections of record clearly exhibit legal and/or factual deficiencies. Applicant reserves all rights to address the matters herein and any additional matters on appeal in a subsequent appeal brief.

Claims 26-29, 31, 33, 34, and 46-49 are pending. The Examiner rejected claims 26-29, 31, 33, 34, and 46-49 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In addition, the Examiner rejected claims 26-29, 31, 33, 34, and 46-49 under 35 U.S.C. § 102(b) as being anticipated by Morrisette *et al.* (U.S. 2002/0150658) (hereinafter, "Morrisette"). Applicant respectfully traverses these rejections.

In particular, Applicant specifically requests the panel to review the issues below.

Legal Error #1: The Examiner has applied an improper standard for definiteness.

Claims 26-29, 31, 33, 34, and 46-49 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner asserted that the term "powder" is indefinite in scope.

Applicant respectfully disagrees. The standard for satisfaction of 35 U.S.C. § 112, second paragraph, is whether "one skilled in the art would understand what is claimed." *See Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.* 927 F.2d 1200 (Fed. Cir. 1991). In addition, the Federal Circuit has stated that claims need only "reasonably apprise those skilled in the art" as to their scope and be "as precise as the subject matter permits." *See Hybritech Inc. v. Monoclonal*

Antibodies, Inc., 802 F.2d 1367 (Fed. Cir. 1986). Moreover, MPEP § 2111 states that claims must be given their broadest reasonable interpretation *consistent* with the specification; this interpretation must be *consistent* with the interpretation that those skilled in the art would reach. Importantly, the section goes on to state that the “plain meaning” is the ordinary and customary meaning given to the term by those of ordinary skill in the art, and that it is the use of the words in the *context of the written description and customarily by those skilled in the relevant art* that accurately reflects the “ordinary” and “customary” meaning of the terms (emphasis added). One having ordinary skill in the relevant art, or nutritional supplement products here, would understand the scope of the term “powder” and would interpret the term “powder” consistently with the generally accepted definition of the term to mean a substance consisting of ground or finely divided or dispersed solid particles.¹ There is simply nothing in the specification to indicate otherwise, nor is there a requirement, given the context of nutritional supplements, for Applicant to have defined the term “powder” with some sort of exacting size distribution. The Federal Circuit has stated that a “patentee need not define his invention with mathematical precision in order to comply with the definiteness requirement.” *See In re Marosi*, 710 F.2d 799, (Fed. Cir. 1983). Moreover, Applicants note that the term “powder” is indicated in the specification to be one example of a “form” of a base (the dietary supplement here); the other possible forms include solid, semi-solid, and liquid; *see* p. 4, lines 17-18. To indicate that the base can be in “powder” form as one form in addition to solid or liquid forms is consistent with a definition of powder which indicates that powder particles behave intermediately between that of a solid and a liquid.² Given all of the above, Applicant respectfully asserts that the term “powder” is not indefinite, as one having ordinary skill in the art would understand the scope of the term in the context of nutritional supplements consistently with the context of the term in the specification. The Examiner has thus applied an improper standard for definiteness given the specification, context, and case law referenced above.

Legal Error #2: The Morrisette reference does not anticipate the pending claims.

¹ See definitions of “powder” amended to the Office Action Response dated August 8, 2007.

² See Google.com compilation of definitions, from Office Action Response dated August 8, 2007, the entry: unistates.com/rt/explained/glossary/rmtglossarypq.html

Claims 26-29, 31, 33, 34, and 46-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Morrisette. In particular, the Examiner alleged that Morrisette teaches a kit comprising a dietary supplement powder product, because the Examiner stated that the term powder reads on “ready-to-eat cereal.”

Applicant respectfully disagrees. A claim is anticipated under § 102(b) only if each and every limitation is disclosed in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 639 (Fed. Cir. 1989) and MPEP § 2131. Present claim 26 recites, among other things, a kit for making a nutritional supplement comprising a dietary supplement product, where the dietary supplement product is a powder. For the prior reasons of records as well as those discussed herein, Applicant asserts that neither of the terms “dietary supplement” or “powder” read on any of the food components disclosed in Morrisette. Morrisette discloses that food components such as ready-to-eat cereals (e.g., whole wheat flakes) or the gasified candy known as “poprocks” can be included in his food package system. It is simply unreasonable to assert that cereal flakes and poprocks anticipate the claim terms “powder” and “dietary supplement.”

Applicant respectfully assert that the term “dietary supplement” is a term of art having a defined meaning. One having ordinary skill in the art would have understood, from a time well before the date of the present filing, that the term “dietary supplement” means products that are intended to supplement the diet and that are not represented for use as a conventional food or staple of the diet. Indeed, as previously stated in a Response dated March 6, 2006, in the United States, a dietary supplement is defined under the Dietary Supplement Health and Education Act of 1994 as a product that meets each of the following criteria:

1. It is intended to supplement the diet and bears or contains one or more of the following dietary ingredients: a vitamin, a mineral, an herb or other botanical (excluding tobacco), an amino acid, a dietary substance for use by man to supplement the diet by increasing the total daily intake (e.g., enzymes or tissues from organs or glands), a concentrate, such as a meal replacement or energy bar, or a metabolite, constituent, or extract.
2. It is intended for ingestion in pill, capsule, tablet, or liquid form.
3. It is not represented for use as a conventional food or as the sole item of a meal or diet.

4. It is labeled as a "dietary supplement".³

Thus, as can be seen from the above, the term "dietary supplement" has had a defined meaning since 1994 to one having ordinary skill in the art. In further support, Applicant refers to page 4, line 7 of the present specification, where dietary supplement bases "such as a muscle building or protein powder" are described, dietary supplement bases that are consistent with the above definition and that are clearly not conventional foods. Applicant respectfully asserts that one having ordinary skill in the art would therefore understand ready-to-eat-cereals, to be a conventional food, and not a "dietary supplement." Moreover, the guidelines would require a ready-to-eat cereal to be labeled as a "dietary supplement" if it were considered such by those having ordinary skill in the art, which it is not.

As indicated above, a "powder" is generally accepted to be a *ground or finely divided* particulate composition. Neither "poprocks" nor a ready-to-eat cereal, such as the whole-wheat flakes of Morrisette, are "ground" or "finely" divided particles, let alone "dietary supplements" in such a form.

In an Office Action dated October 18, 2007, in responding to Applicant's previous response, the Examiner stated that "[a] critical read of the prior art includes, for example, fluid batters which is a powder in combination with a liquid. Moreover, the Morrisette teaches that this fluid batter can be dry (col 2, ll. 16-17)."

Applicant respectfully disagrees with the Examiner's interpretation of the prior art. With respect to the fluid batter, as pointed to by the Examiner, Morrisette states:

In still another variations [*sic*] the *wet material component* can comprise a *fluid batter* such as a farinaceous batter for chemically leavened baked goods (e.g., layer cakes, muffins, quick breads, brownies or other dessert baked goods) or pan goods (e.g., pancakes) such as including an acidulant or at least one baking acid and the *dry component can be a chemical leavening system or component thereof such as baking powder or soda* (sodium bicarbonate) (Col. 2, lines 2-9; emphasis added).

Accordingly, Applicant asserts that Morrisette is disclosing the separation of a fluid batter (e.g., an acidulant or baking acid containing component) from a dry component (e.g., a chemical leavening system). A fluid batter is not a "dietary supplement." Moreover, even if one were to interpret a fluid batter to be a "dietary supplement," at no point does Morrisette state that the

³ See attached documents in Response to Office action dated March 6, 2006

fluid batter could be in powder or dry form as asserted by the Examiner. In fact, Morrisette defined the fluid batter as the *wet* component of the invention. The Examiner alleges that the fluid batter can be dry by citing the following from Morrisette:

In still other variations, each food component can be dry but of differing water activities or moisture content. For example, one food component can be a dry ready-to-eat cereal with a water activity below about 0.3 (A_w less than 0.3), e.g., whole wheat flakes, while the second food ingredient has a higher water activity, e.g., raisins having a $A_w \approx 0.4$ (col. 2, lines 15-21).

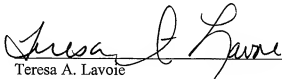
Applicant respectfully asserts that the Examiner has clearly taken the above passage out of context.

In light of the above, Applicant asserts that the Examiner has applied an improper standard for definiteness. Applicant asserts that the term "powder" has a plain meaning (i.e., a substance consisting of ground or finely divided or dispersed solid particles) which would be understood by one of ordinary skill in the art based on the use of the term in the art and the context in which the term is used throughout the specification. With respect to the Examiner's § 102(b) rejection, Applicant asserts that Morrisette does not anticipate the pending claims. Specifically, the ready-to-eat cereal, "poprocks", and fluid batter of Morrisette are not "dietary supplements" in "powder" form as required by the instant claims. Accordingly, Applicant respectfully requests that the panel withdraw the rejections of claims 26-29, 31, 33, 34, and 46-49 under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 102(b).

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 1/17/08


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